



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/926,079	08/27/2001	Keiji Uehara	213253US2SPC	1952

22850 7590 09/10/2004

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

SING, SIMON P

ART UNIT	PAPER NUMBER
----------	--------------

2645

5

DATE MAILED: 09/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/926,079

Applicant(s)

UEHARA ET AL.

Examiner

Simon Sing

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12062001.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claim 16 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Since the first storing means and the second storing means are being an integral structure (parent claim 15), it would be impossible to insert the integral structure into both sides of a cellular phone.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-3 and 7 are rejected under 35 U.S.C. 102(e) as being anticipated by Miller et al. US 6,141,563.

2.1 Regarding calcium 1, Miller discloses a mobile telephone 101 in figure 1. Miller teaches:

a first interface means, such as SIM Card Reader 107, for connecting a SIM Card 105 (first storing means) storing information including subscriber's information for communication with a mobile communication system (figure 2; column 1, lines 34-41; column 3, lines 3-6);

a second interface means, for connecting a program memory 119 (second storing means) to a controller, the program memory 119 stores operational programs for the mobile telephone 101 (column 3, lines 17-20).

2.2 Regarding claim 2, Miller teaches that the operational programs operate the mobile telephone 101, which inherently includes notifying a user (by a light, a ringing tone, or a vibrator) of an incoming call (column 3, lines 17-20).

2.3 Regarding claim 3, Miller teaches a speech control means for responding to an incoming call, such as circuitries for interfacing a microphone and a speaker in the user interface 109 (column 3, lines 26-29, 34-39, 46-50).

2.4 Regarding claim 7, Miller teaches that the mobile telephone 101 is a subscriber unit used in a cellular communications network (column 1, lines 12-19, 34-41; column 2, lines 41-56).

3. Claims 1-3 and 6-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Ali Vehmas et al. US 6,223,052.

3.1 Regarding claim 1, Vehmas discloses a cellular telephone 1 in figure 1. Vehmas teaches:

a first interface for connecting a first storing means SIM1 storing a subscriber's information with a mobile communications system (column 3, lines 56-63; column 1, lines 21-36) ;

a second interface for connection a second storing means SIM12 storing an application program executable on the cellular telephone 1 (column 4, lines 19-29; column 1, lines 21-36).

3.2 Regarding claim 2, Vehmas teaches using an application program stored in a SIM card for operating said cellular telephone 1 (column 4, lines 54-58).

3.3 Regarding claim 3, it is inherent that a cellular telephone has a speech control means for processing audio signals from a microphone and to a speaker (earphone).

3.4 Regarding claim 6, Vehmas teaches that a SIM card is a smart card (column 1, lines 37-47), which stores both a subscriber's information and application programs (column 1, lines 27-36), and data in a smart card is transferable with a cellular telephone (column 1, lines 15-26).

3.5 Regarding claim 7, Vehmas teaches using an application program stored in a SIM card for operating said cellular telephone 1 (column 4, lines 54-58). Operating a cellular telephone inherently including communicating with a wireless communications network.

3.6 Regarding claim 8, Vehmas teaches that both storing means are removable (column 6, lines 7-12).

3.7 Regarding claim 9, Vehmas teaches that a SIM card is a smart card (column 1, lines 37-47), which stores subscriber's information and application programs (column 1, lines 27-36), and data in a smart card is transferable with a cellular telephone (column 1, lines 15-26).

3.8 Regarding claim 10, Vehmas teaches that a single card reader is able to read both storing means (column 6, lines 7-12).

3.9 Regarding claim 11, Vehmas teaches an external card reader (housing) 10 (figure 1; column 4, lines 14-26).

3.10 Regarding claim 12, Vehmas teaches that a single card reader is able to read both storing means (column 6, lines 7-12).

3.11 Regarding claim 13, Vehmas teaches displaying a menu for assigning priorities to SIM cards, and a message if a conflict occurs (column 5, lines 40-63).

3.12 Regarding claim 14, Vehmas teaches that a SIM card is a smart card (column 1, lines 37-47), which stores both a subscriber's information and application programs (column 1, lines 27-36).

3.13 Regarding claim 15, Vehmas teaches that a single card reader is able to read both storing means (column 6, lines 7-12). Vehmas further teaches that a SIM card is a smart card (column 1, lines 37-47), which comprises a first storing means (subscriber's information) and a second storing means (application programs) (column 1, lines 27-36).

3.14 Regarding claim 16, Vehmas teaches that SIM cards are interconnected to an microprocessor 7 (figure 1), and internal card reader and external card reader are interchangeable (column 6, lines 1-11). Vehmas further shows that SIM1 is inserted at one side of cellular telephone 1, and SIM2 is inserted at another side of said cellular telephone (figure 1).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miller et al. US 6,141,563 in view of Barabash et al. US 6,101,378.

Miller teaches a mobile telephone with operational programs stored in a memory, but fail to teach notifying a user if the number of incoming calls reaches a preset number.

However, Barabash discloses a pre-paid cellular telephone system in figure 1 (column 2, lines 54-67). Barabash teaches that if a user's pre-paid balance (or minutes) is depleted, the user is notified (column 5, lines 19-55).

Therefore, since the number of minute is analogous to number of calls, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Miller's reference with the teaching of Barabash, so that the mobile telephone would have notified a user if a preset number of calls had been reached, because such modification would have alerted a user of the termination of his/her subscription of mobile communications.

5. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miller et al. US 6,141,563 in view of Vossler US 6,317,593.

Miller teaches a mobile telephone with operational programs stored in a memory, but fail to teach notifying a user if an incoming call is within a preset time.

However, Vossler discloses a cellular telephone 100 in figure 1 (column 3, lines 16-31). Vossler teaches an automatic schedule program for automatically activating or deactivating cellular telephone 100 (column 4, lines 3-18; column 5, lines 48-67; column 5, lines 1-18; figure 4).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Miller's reference with the teaching of Vosller, so that the mobile telephone would have been only operable at a predetermined schedule, because such modification would have filtered out incoming calls at theaters, during meeting or meal time.

6. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miller et al. US 6,141,563 in view of Phillips et al. US 6,400,965.

Vehmas teaches that a SIM card is a smart card (column 1, lines 37-47), which comprises a first storing means (subscriber's information) and a second storing means (application programs) (column 1, lines 27-36). Vehmas further teaches that a SIM card is inserted into the housing of cellular telephone 1 (column 3, lines 56-63), but fails to teach that a SIM card is inserted from a space provided for a battery.

However, Phillips discloses a cellular phone having a SIM card. Phillips teaches that a SIM card 300 is inserted into its reader 400 beneath a battery (column 2, lines 45-54).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Vehmas's reference with the teaching of Phillips, so that the SIM card would have been inserted from a space provided for a battery, because such a modification would have further secured a SIM card by placing it beneath a battery.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a) Yamane et al. US 5,884,200, discloses a mobile phone with two SIM cards (figure 6).

b) Erkkila et al. US 6,219,560, discloses a mobile phone with external card interface (figures 5-7).

c) Heinonen et al. US 6,418,326, discloses a mobile phone with a SIM card (figures 2 and 3).

d) Martschitsch US 6,223,026, discloses a prepaid mobile subscriber ID card.

8. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Simon Sing whose telephone number is (703) 305-3221. The examiner can normally be reached on Monday - Friday from 8:30 AM to 5:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached at (703) 305-4895. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4750.

Application/Control Number: 09/926,079

Page 11

Art Unit: 2645

Allan Hoosain
ALLAN HOOSAIN
PRIMARY EXAMINER *for*
Fan Tsang

SS

S.S.

08/26/2003